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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
MACKEY, J

ART UNIT	PAPER NUMBER
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Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/363,129	SWAAB
Examiner	**Art Unit**
James Mackey	1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 13, 2001*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-12 and 25-33* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-12 and 25-33* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2½,3
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

1. Applicant's election without traverse of Group I, claims 1-12 and new claims 25-33 (and the cancellation of non-elected claims 13-24), in Paper No. 6 is acknowledged.

2. Applicant should update the Title to reflect the elected invention (i.e., apparatus only).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 6, 10, 11 and 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, line 3, "conventional mold" is of indefinite scope, since the metes and bounds of what is considered to be "conventional" cannot be ascertained.

Claims 6 and 31 are indefinite since they use the term "mold" in a manner contrary to its accepted meaning. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "mold" in claims 6 and 31 is used by the claim to mean "jar" or "container," while the accepted meaning is "an apparatus having a shaping/molding surface which shapes a fluent material into a self-sustaining article." Note that "mold" in the remaining claims is being interpreted according to its accepted meaning.

In claim 10, "the mold top and bottom clam shells" on lines 1-2, and "the mold top and bottom" on line 3 both lack proper antecedent basis in the claim.

In claim 11, line 2, "adapted to houses" is grammatically incorrect.

In claim 25, line 3, "a plurality pigments" should be --a plurality of pigments--.

5. Claims 29 and 30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 29 and 30 only recite the intended use of the claimed kit apparatus, by merely reciting where and how the claimed kit is intended to be used; such relates only to the manner or method in which the kit is intended to be operated, which does not structurally distinguish the claimed kit, and therefore does not further limit the structure of the claimed kit. Note that intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder,* 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-5, 7-30, 32 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,971,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims directed to a kit for custom blending of lip coloring product are fully encompassed by the patent claims directed to a kit for custom blending of lipstick.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 6 and 31 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

According to the Statement filed on Oct. 7, 1999, custom blended lip gloss was on sale more than one year before this CIP application was filed. Note that, since parent application S.N. 08/924,196 does not provide descriptive support (under 35 USC 112, first paragraph) for the custom blending kit to form lip gloss stored in lip balm jars, the "critical date" for such a claim limitation is one year before the filing date of the instant application.

10. Claims 1; 3-6, 11, 12, 25, 26, 29-31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Patent 5,780,018).

Collins et al. teach a kit (col. 4, lines 3-8) comprising a plurality of pigment containers, at least one base (oil blend) container, at least one measurer for measuring quantities of material (the "dispenser adapted to dispense a known dose", col. 4, line 7; see also col. 6, lines 28-29), a mixing vessel, a mixing means (col. 2, lines 12-16; see also col. 6, line 32, reciting a "spatula"), and a moulding means (col. 2, lines 19-24). The mixed blend is adapted to be heating in a heating vessel by a heating means (col 2, lines 3-5). The heated blend may be molded and joined to a lipstick case or poured in a container (col. 2, lines 17-24).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-12 and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al. (U.S. Patent 5,780,018).

Collins et al. teach a kit (col. 4, lines 3-8) comprising a plurality of pigment containers (containing any conventional lipstick pigment or pearlizing agent, col. 2, lines 62-64), at least one base (oil blend) container, a mixing vessel, a mixing means (col. 2, lines 12-16; see also col. 6, line 32, reciting a "spatula"), and a moulding means (col. 2, lines 19-24). The mixed blend is adapted to be heating in a heating vessel by a heating means (col 2, lines 3-5). The heated blend may be

molded and joined to a lipstick case or poured in a container (col. 2, lines 17-24). While Collins et al. describe that "measurements of ingredients are not required" (see col. 3, lines 65-66; however, note col. 3, lines 43-47 which state that the pigment may be in the form of a semi-solid paste which is to be "divided into a number of identical color units", inherently utilizing some sort of measuring means to achieve such identical dividing), Collins et al. also describes that it is known to provide pigments and pastes which are to be measured prior to blending and molding (see col. 1, lines 40-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lipstick forming kit taught by Collins et al. by providing a measuring means to dispense measured quantities of pigments and bases, since Collins et al. discloses that such is known in the lipstick field of endeavor. Note that a reference is not limited to the preferred embodiments, *In re Boe*, 148 USPQ 507 (see also *In re Gurley*, 31 USPQ2d 1130, and *In re DeLisle*, 160 USPQ 807). Collins et al. further teaches the use of additives (col. 2, lines 32-38, and col. 3, lines 7-9), and it would have been obvious to a skilled artisan to have provided the lipstick forming kit taught by Collins et al. with additives such as fragrances to be added to the blend, since Collins et al. recognizes that plural diverse additives are known for use in lipstick formulations, and since such would permit the selective use of any desired additives for a particular lipstick. While Collins et al. merely describes the mold for molding of the lipstick as "a single or multiple cavity split mould" (col. 2, lines 20-21), it would have been obvious and well within the level of ordinary skill in the art to have provided any known mold for forming lipsticks,

including clamshell-type split molds, in order to facilitate the molding of the lipstick and to mold the lipstick directly into a lipstick case (see col. 2, line 24).

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651. Any inquiry relating to the contents or papers filed in this application, other than issues of substance requiring the attention of the Examiner, should be directed to the Customer Service Office, Technology Center 1700, whose telephone number is (703) 306-5665.

MACKEY/jpm
September 24, 2001

JAMES MACKEY
PRIMARY EXAMINER
ART UNIT 1722

9/24/01